

Appl. No. 09/773,943  
Preliminary Amendment and  
Response to Office Action

Docket No. 85804-019600

### **REMARKS**

Claims 1, 2 and 4 to 26 are the pending claims, of which Claims 1, 8, 9, 12 and 16 are the independent claims. Claims 1, 2, 8, 9 and 12 are being amended, and Claims 16 to 26 are being added. Reconsideration and further examination are respectfully requested.

Initially and with regard to a formal matter, the Office Action requested another copy of two references submitted with an Information Disclosure Statement mail-dated March 20, 2003, for consideration by the Examiner. A copy of each of the references is enclosed, together with a copy of the Form PTO/SB/08B which lists these references. The Examiner is respectfully requested to indicate that this information has been considered by initialing the appropriate portion of the Form PTO/SB/08B, and to return a copy of the initialed form to Applicants' undersigned representative.

Applicants are amending the specification independent of any matter raised in the Office Action. More particularly, the specification is amended to specifically include the reference numerals corresponding to the elements used in Figures 3, 3A and 3B. In certain cases, the specification is amended to include the text associated with an element. It is submitted that the amendments made to the specification are fully supported by the specification, including the drawings (of which Figures 3, 3A and 3B are a part) as originally-filed. Accordingly, it is submitted that no new matter is being added.

By the Office Action, Claims 1, 2 and 4 to 15 are rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,760,916 (Holtz). Reconsideration and withdrawal of the rejection are respectfully requested.

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Applicants renew their request for a showing to establish that Holtz is prior art. In response to Applicants' previous request, the Examiner concedes in the current Office Action that he is relying on the disclosure of U.S. Application Serial No. 09/634,735 (Snyder) and its August 8, 2000 filing date in order to apply the disclosure of Holtz against the claims of the present Application.<sup>1</sup>

The Office Action contends (at page 4) that pages 68 to 78 of Snyder demonstrate that "full support for the disclosure needed to reject applicant's claims was present in [Holtz]". Assuming *arguendo* that the disclosure needed to reject Applicants' claims is present in Holtz (a fact that is in no way conceded), a rejection based on Holtz is still not proper unless it can first be shown that Holtz is prior art to the claimed invention. No such showing has been made.

It is respectfully pointed out that Holtz is a continuation-in-part of Snyder and therefore by definition it contains new matter not previously described in Snyder. See MPEP § 201.08. There has been no showing that the subject matter of Holtz relied upon to reject the claims of the present Application is not new matter. Absent such a showing, Holtz cannot be said to be prior art. See 35 U.S.C. § 112 and MPEP § 2136.03.

Accordingly, Applicant renews the request for the Examiner to provide a showing that establishes that each and every portion of the subject matter of Holtz relied upon to reject the claims of the present application is fully supported by Snyder and is not new matter, in accordance with 35 U.S.C. § 112 and MPEP § 2136.03.

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<sup>1</sup> After the current Office Action was mailed, U.S. Application Serial No. 09/634,735 issued as U.S. Patent No. 7,024,677 on April 4, 2006.

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While it is not applied against the claims of the present invention, Applicants submit that Snyder is missing multiple elements of the claim, and therefore Snyder can not be relied upon as an anticipatory reference, nor can it form the basis of a satisfactory obviousness rejection.

Claim 1 recites a method for providing streaming multimedia advertisements. According to the method, a frame set is built in a browser window, the frame set comprises a media player frame to experience streaming content from a media player executing at said user computer and a data frame. A playlist requested from a source on a network is received. The playlist's contents are other than streaming content and comprise a list of references identifying streaming advertisement and media content. Each reference includes an indicator that indicates when the advertisement should be played in relation to the media content. The user computer connects to at least one media server to retrieve the streaming advertisement and media content from the server using the playlist's contents. The streaming content is simultaneously played in the media player frame as the HTML content is displayed in the data frame.

Snyder describes an automated video production system used to create video streaming media of a show that can then be broadcast live or "on-demand" to a user. According to Snyder and in the portion of Snyder referenced in the Office Action, an "on-demand" user selects icons representing the streaming video segments of a show or of an entire show that the user wishes to view. The video production system collects all of the streaming video selected by the user in a "bin" playlist before it transmits the streaming video to the user's computer. While Snyder describes a "bin" playlist, according to Snyder a "bin" playlist consists of the streaming video segments collection for broadcast to the user's computer. A "bin" playlist that contains streaming video segments cannot be said to be the same as an advertisement playlist that does not contain streaming content.

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Furthermore, Snyder describes a transition macro defined by a video show's director using a graphic user interface (GUI), the transition macro identifying video production commands to control video production devices, such as cameras, teleprompters, recording devices, etc., to create the streaming video for a show. A script file is generated as the show is being produced to contain the show's transition macros, time stamps for each video segment of a show created, and streaming advertisement content. A script file is used to create the "bin" playlist, discussed above. However, a transition macro used to control video production devices in an automated video production system that creates streaming content, or a script file used to collect the streaming content into a "bin", cannot be said to be the same as a playlist containing other than streaming content which is transmitted to a user computer, and used by the user computer to connect to a media server to retrieve streaming advertisement and media content from the server using the media player executing on the user computer.

Nothing in Snyder discloses, suggests or teaches a user computer receiving a playlist whose contents are other than streaming content and comprise a list of references identifying streaming advertisement and media content, and each reference includes for each advertisement an indicator that indicates when the advertisement should be played in relation to the media content. Nothing in Snyder discloses, suggests or teaches a user computer connecting to at least one media server to retrieve streaming advertisement and media content from the server using the playlist's contents.

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

The Applicant respectfully requests that a timely Notice of Allowance therefore be issued in this case. Should matters remain which the Examiner believes could be resolved in a further

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telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

In this regard, Applicant's undersigned attorney may be reached by phone in California (Pacific Standard Time) at (714) 708-6500. All correspondence should continue to be directed to the below-listed address.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred when charging any payments or credits for this case.

Respectfully submitted,

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